

## REMARKS

In response to the Office Action of 6/19/2001(Paper #19), the Applicant has amended Claim 78. Claims 75-94 remain in the case. The Applicant hereby respectfully requests further examination and reconsideration of the application as amended.

In the Office Action of 6/19/2001, claims 78-80 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

In particular, the Office Action correctly pointed out a typographical error relating to the dependency of Claim 78. As noted by the Office Action, Claim 78 was indefinite because it should depend from Claim 77 rather than from Claim 3. Consequently, Claim 78 has been amended to reflect the correct dependency from Claim 77. Thus, the applicant respectfully requests reconsideration of the rejection of Claim 78, as amended, and of Claims 79-80 which depend therefrom under 35 U.S.C. §112, second paragraph.

In the Office Action of 6/19/2001, Claims 75-77, 81-82, 86-87, and 92-94 were rejected under 35 U.S.C. §102(b) as being anticipated by **Dumben** (U.S. Patent #1,780,872). A rejection under 35 U.S.C. §102(b) requires that the Applicant's invention was patented or described in a printed publication more than one year prior to the date of application for patent. To establish that a publication describes the Applicant's invention, all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the prior art, then a rejection under 35 U.S.C. §102(b) is not proper.

In particular, the Office Action first asserts that the **Dumben** reference teaches "a flat planar rigid base (5) and a pair of support members (17) disposed on a top surface of the base." Figure 2 of the **Dumben** reference is offered as evidence of this assertion. However, the **Dumben** base (5), as illustrated by figures 2-6, is neither flat, nor planer. In fact, as described by **Dumben** on page 1, lines 60-65, the **Dumben** base is actually a

hollow housing having supporting legs (6). Further, as clearly illustrated by Figures 1, 3, 4, 5, and 6 of the **Dumben** reference, the pair of "book ends" (17) (e.g., the "*support members (17)*" identified by the Office Action) are **not** disposed on the top surface of the base, as described and claimed by the present invention. In fact, these book ends (17) are actually coupled to and supported by blocks (16) that are slidably mounted within a longitudinal slot (8) in the base (5). These blocks (16) are in turn coupled to guide pieces (12) that are disposed on the **lower surface** of the base (5).

Next, the Office action asserts that the "support members are slidably engaged (16) with the top surface of the base." In fact, as described above, the **book ends (17)** are supported by **blocks (16)** which are slidably engaged **within a longitudinal slot (8)** in the base, see **Dumben** page 2, lines 5-10. While the Office Action initially attempted to equate the "book ends (17) of the **Dumben** reference to the support members of the present invention (see above discussion, it appears that the Office Action is now suggesting that the blocks (16) of the **Dumben** reference are equivalent to the support members of the present invention. Clearly, both element 17 and element 16 can not individually be equivalent to the support members of the present invention.

However, in any event, there is no commonality whatsoever between the blocks (16) of the **Dumben** reference and the support members of the present invention. First, the blocks (16) of the **Dumben** reference support the **Dumben** book ends (17). In contrast, the support members of the present invention include planar holding surfaces for engaging articles that are to be held by the support stand. Second, the **Dumben** blocks (16) are not slidably engaged with the top surface of the base, as they are clearly disposed within the longitudinal slot (8) in the base as illustrated by Figures 4, 5 and 6. In contrast, the support members of the present invention are clearly slidably disposed **with the top surface** of the base, and **not** within a slot within the base as described by **Dumben**.

The Office Action continues by asserting that **Dumben** teaches a "securing apparatus (19) capable of releasably securing the support members. However,

elements 19 of the **Dumben** reference are actually screws which are “employed for securing the slidable blocks 16 and the slidable floating member 12 to the bracing members 18 which may be secured to the book end supports 17...” (See **Dumben** page 2, lines 15-18). As noted above, it appears that that the Office Action has equated the support members of the present invention to the “book ends” (17) of the **Dumben** reference. ***Note that Dumben also refers to a second set of screws as element 18. Consequently, for purposes of the discussion in this response, these Dumben screws 18 should not be confused with the Dumben bracing members 18.***

Clearly, the **Dumben** screws (19) are **not** used in the manner suggested by the Office Action. In particular, the **Dumben** screws (19) do **not** releasably secure the support members, and instead simply hold together elements that are slidably disposed within and under the slot (8). Further, while it is true that such screws releasably secure the slidable blocks 16 and the slidable floating member 12 **to the bracing members 18**, it should be noted that the apparent effect of removing these screws (19) would be to cause each bracing member (18) to become unsecured from its support structure, thereby likely reducing any lateral support of the book ends (17). Clearly, the **Dumben** screws do not operate as suggested by the Office Action, as they simply do **not** prevent relative motion between the base and the bookends.

In stark contrast, the securing apparatus of the present invention, as claimed by claim 75 clearly states that the applicant's securing apparatus is “capable of releasably securing the first support member to the base so as to prevent relative motion between that member and the base.”

The Office Action continues by asserting that Figure 2 of the **Dumben** reference shows that the “second support member is permanently affixed to the base (figure 2) and slidably engaged with the surface of the base.” However, Figure 2 of **Dumben** shows no such thing. In fact, it is not apparent how anything that is permanently affixed can also be slidably engaged at the same time. The two embodiments are by nature mutually exclusive. In any event, it is clear from Figures 1, 3, 4, 5 and 6, and from the

text of the specification of the **Dumben** reference that both of the **Dumben** book ends (17) are adjustable along the length of the slot (8) in the base (5), and that neither book end is permanently affixed to the base.

In view of the above discussion, it is clear that that the apparatus described by the **Dumben** reference does not describe the applicant's claimed invention. Thus, the applicant respectfully traverses the Office Action's contention under 35 U.S.C. §102(b) that the Applicant's invention was patented or described by the **Dumben** reference. In particular, the applicant contends that the claimed invention is patently distinct from the apparatus described by the **Dumben** reference based on the novel claim language of independent claims 75 and 92. In particular, claim 75 claims, *inter alia*:

“a pair of support members ***disposed on the top surface of the base...*** wherein ***a first of the pair of support members is slidably engaged with the top surface of the base...***

***a securing apparatus capable of releasably securing the first support member to the base, so as to prevent relative motion between that member and the base.***” (emphasis added)

Similarly, claim 92 claims, *inter alia*:

“a single ***support member disposed on a top surface of the base...*** wherein the support member is ***slidably engaged with the top surface of the base;***

***a first securing apparatus capable of releasably securing the support member to the base so as to prevent relative motion between that member and the base;***” (emphasis added)

The Office Action rejected claims 78 and 83 under 35 U.S.C. §103(a) as being unpatentable over **Dumben** in view of Helfman, *et al.* (U.S. Patent No. 5,822,918, **Helfman**). In order to deem the Applicant's claimed invention unpatentable under 35

U.S.C. §103(a), a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (In Re Fine, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

The Office Action suggests that **Dumben** *“teaches the second leg of the first support member comprising a slot oriented (8) and the securing apparatus comprises a threaded pin (19) substantially perpendicular from the top surface of the base. The threaded pin having a distal end that extends through the slot of the first support member (figure 4). **Dumben** teaches the securing apparatus, but fails to teach a threaded knob.”* (emphasis added) The Office Action then suggested that it would have been obvious for one of ordinary skill in the art to have added a threaded knob to the **Dumben** threaded pin as taught by **Helfman**.

It appears that the Office Action has mistakenly construed the operation of the **Dumben** screws (19). As noted above, these screws (19) are not a “securing apparatus” as described and claimed by the present invention. In fact, the **Dumben** screws (19) merely act to help secure the slidable blocks 16 and the slidable floating member 12 *to the bracing members 18*. Further, *it should be noted that the apparent effect of removing these screws (19) would be to cause each bracing member (18) to become unsecured from its support structure, thereby likely reducing any lateral support of the book ends (17)*. Clearly, the **Dumben** screws do not operate as suggested by the Office Action, as they simply do **not** prevent relative motion between the base and the bookends. The addition of the **Helfman** threaded knob to the **Dumben** screws (19) would likely make it easier to assemble or disassemble the **Dumben** apparatus. However, such a combination has nothing whatsoever to do with the claimed securing apparatus of the present invention. Thus,

as ease of assembly and disassembly of particular components of the present invention using a threaded knob is not a claimed element of the present invention, it is clear that the addition of the **Helfman** threaded knob to the **Dumben** screws (19) in no way operates to make the securing apparatus of the present invention obvious.

Clearly, the combination of **Dumben** in view of **Helfman**, does not teach the limitations of the Applicant's claimed invention. Consequently, no prima facie case of obviousness has been established in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that rejected Claims 78 and 83 are patentable under 35 U.S.C. §103(a). Consequently, the Applicant respectfully traverses the rejection of claims 78 and 83 under 35 U.S.C. §103(a) in view of the above discussion.

With respect to the rejections of claims 88 and 90-91 under 35 U.S.C. §103(a) as being unpatentable over **Dumben**, it should be noted that claims 88 and 90-91 are dependent from independent claim 75. The Office Action has made no suggestion that independent claim 75 is unpatentable under 35 U.S.C. §103(a). Further, in accordance with the preceding discussion, claim 75 has been shown to be allowable under 35 U.S.C. §102(b). Consequently, as there is no appropriate outstanding rejection of the parent claim, any rejection of the dependent claim is moot. Therefore the Applicant respectfully traverses the rejection of claims 88 and 90-91 under 35 U.S.C. §103(a) in view of the above discussion.

Similarly, with respect to the rejection of claim 89 under 35 U.S.C. §103(a) as being unpatentable over **Dumben**, in view of **Hunter** (U.S. Patent No. 4,966,340) it should be noted that claim 89 is dependent from independent claim 75. The Office Action has made no suggestion that independent claim 75 is unpatentable under 35 U.S.C. §103(a). Further, in accordance with the preceding discussion, claim 75 has been shown to be allowable under 35 U.S.C. §102(b). Consequently, as there is no appropriate outstanding rejection of the parent claim, any rejection of the dependent

claim is moot. Therefore the Applicant respectfully traverses the rejection of claim 89 under 35 U.S.C. §103(a) in view of the above discussion.

**Version with Markings to Show Changes Made**

Claim 78 (Once amended). The support stand of Claim 77[3], wherein the second leg of the first support member comprises a slot oriented so as to be substantially perpendicular to the face forming the planar holding surface of the first support member, and wherein the securing apparatus comprises,

a threaded pin protruding substantially perpendicular from the top surface of the base which has a distal end that extends through the slot of the first support member, and

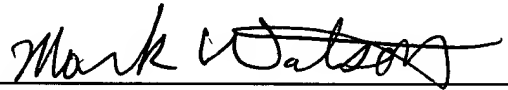
a threaded knob which is threadably mated to the threaded pin and which in a disengaged mode allows the first support member to be slid in relation to the base, and in an engaged mode wherein the knob is rotated down on the pin so as to compress the second leg of the first support member against the top surface of the base, prevents the first support member from sliding in relation to the base.



### CONCLUSION

In view of the above discussion, it is respectfully submitted that claims 75-94 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 75-94, and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark A. Watson", is written over a horizontal line.

Mark A. Watson  
Registration No. 41,370  
Attorney for Applicant

Lyon, Harr and DeFrank, LLP  
300 Esplanade Drive, Suite 800  
Oxnard, California 93030  
(805) 278-8855